

### REMARKS

Reconsideration of the present application in view of the remarks below and the amendments above is respectfully requested.

Claims 1-24 were pending in this application. Claims 1-7 and 9-24 were rejected. Claim 8 was found allowable. Claims 1, 2, 9, and 12 have been amended. Presently, Claims 1 to 24 remain under consideration in the present application.

Claim 1 has been amended to delete the phrase “each alkyl is optionally substituted with one, two, three or four substituents independently selected from  $R^a$ , and” from the definition of  $R^2$ . Also, the spelling of “alky” has been corrected to “alkyl” in  $R^1$ . Still further, consistent with each of the exemplified compounds,  $R^3$  has been amended to be optionally substituted  $C_{1-4}$  alkyl, by the deletion of the element “hydrogen” from the Markush group, and provisos affecting compounds wherein  $R^3$  is hydrogen have been deleted. Support for the deletion of hydrogen is found in originally filed Claim 4, and in the specification at page 15, lines 26 to 28. These amendments do not add new matter to the present application.

Claim 2 has been amended to delete the phrase “each alkyl is optionally substituted with one, two, three or four substituents independently selected from  $R^a$ , and” from the definition of  $R^2$ . Also, the spelling of “alky” has been corrected to “alkyl” in  $R^1$ . These amendments do not add new matter to the present application.

Claim 9 has been amended to define  $R^3$  as optionally substituted  $C_{1-4}$  alkyl, by the deletion of the element “hydrogen” from the Markush group. This is consistent with each of the exemplified compounds, wherein  $R^3$  is alkyl. Support for the deletion of hydrogen is found in originally filed Claim 13, and in the specification at page 15, lines 26 to 28. Additionally, provisos affecting compounds wherein  $R^3$  is hydrogen have been deleted. Still further, the semicolon following “wherein” in the line after structural formula IA, has been replaced with a colon. These amendments do not add new matter to the present application.

Claim 12 has been amended to delete the element “hydrogen” from the Markush group for  $R^3$  and thereby define  $R^3$  as optionally substituted  $C_{1-4}$  alkyl. Support for the deletion of hydrogen is found in originally filed Claim 13, and in the specification at page 15, lines 26 to 28. This amendment does not add new matter to the present application.

### Claim Rejections – 35 USC §112

Claims 1-7 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The

Examiner stated that Claim 1 defined R<sup>2</sup> to be various groups but the alkyl, and at the same time depicts that each alkyl is substituted with various substituents, thus rendering claims indefinite.

Applicants have amended Claims 1 and 2 to delete the phrase “each alkyl is optionally substituted with one, two, three or four substituents independently selected from R<sup>a</sup>, and” from the definition of R<sup>2</sup>. These amendments do not add new matter to the present application.

As amended, the Claims 1 and 2, together with dependent Claims 3-7, are definite and particularly point out and distinctly claim the subject matter which Applicants regard as their invention

In view of the amendments and remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-7 under 35 USC § 112, second paragraph.

### **Claim Rejections – 35 USC §103**

Claims 1-7 and 9-24 were rejected under 35 USC § 103(a) as being unpatentable over GB 899556. The Examiner stated that GB’556 teaches structurally similar compounds, composition and method of use as claimed herein, for example, page 1, column 1, lines 10-20. The Examiner asserted that it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made obtain compounds within the generic disclosure of the reference, because they are structurally so similar to those claimed herein, with the reasonable expectation of achieving a successful pharmaceutical composition, for treating tumors, absent evidence to the contrary, and further noted that R<sup>1</sup> and R<sup>2</sup> in the reference can be halo and methyl or halo and methoxy, thus not covered by the proviso.

Applicants have amended Claims 1, 9, and 12 to define R<sup>3</sup> as optionally substituted C<sub>1-4</sub> alkyl, by the deletion of the element “hydrogen” from the Markush group. Claims 2-7, and 10-24, which depend directly or indirectly from Claim 1 or Claim 9, respectively, incorporate this limitation.

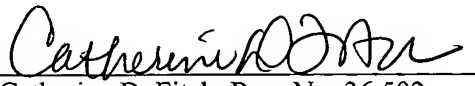
GB ‘556 does not teach or suggest or motivate one of ordinary skill in the art to arrive at the presently compounds having an alkyl group at the R<sup>3</sup> position, compositions comprising these compounds, and methods of treating and preventing diseases and conditions mediated by the cannabinoid 1 receptor. GB ‘556 describes substituted isonicotinic acid amides having a hydrogen substituent on the carbon adjacent to the nitrogen of the amide useful for treating tumors. There is no suggestion or motivation for one of ordinary skill in the art to modify the compounds of GB ‘556 to alkylate at the carbon adjacent to the nitrogen of the amide for any purpose, neither to obtain compounds useful for treating tumors, nor to treat or prevent cannabinoid 1 receptor mediated diseases and conditions. GB ‘556 does not teach or suggest or motivate one of ordinary skill in the art to arrive at the presently compounds having an alkyl group at the R<sup>3</sup> position,

compositions comprising these compounds, and methods of treating and preventing diseases and conditions mediated by the cannabinoid 1 receptor.

In view of the amendments and remarks above, Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1-7, and 9-24 under 35 USC § 103(a) over GB 899556.

Applicants respectfully request reconsideration and withdrawal of the rejection and earnestly solicit a favorable response from the Examiner. The Examiner is invited to contact Applicants' representative at the number below, if such contact would facilitate prosecution of this application to allowance.

Respectfully submitted,

By   
Catherine D. Fitch, Reg. No. 36,502  
Attorney for Applicants

MERCK & CO., Inc.  
P.O. Box 2000  
Rahway, New Jersey 07065-0907  
Tel: (732)594-4283

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